

REMARKS

I. Introduction

Claims 1 to 17 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Objection to the Drawings

The drawings were objected to as allegedly failing to comply with 37 C.F.R. § 1.84 (p)(4) because reference character "42" was allegedly used to designate both bearing supports and stops. Applicant has amended the Specification such that reference character "42" is used only to designate supports. Accordingly, withdrawal of this objection to the drawings is respectfully requested.

The drawings were also objected to because features were allegedly labeled in a foreign language. In both Figure 1 and Figure 2 German text has been translated to English. Specifically, the term "Elektr. Steuergerat" has been replaced with --Electric Control Unit-- and the term "Steuerblock" has been replaced with --Control Block--. Applicant submits that replacement Figures 1 and 2, submitted herewith, overcome this objection to the drawings. Accordingly, withdrawal of this objection to the drawings is respectfully requested.

III. Objection to the Claims

Claims 6 and 10 were objected to for containing terms that are allegedly vague. Applicant respectfully disagrees that claim terms of claims 6 and 10 are vague. Notwithstanding the above, to further expedite prosecution, claims 6 and 10 have been amended to remove the objected to claim terms. Applicant respectfully submits that claims 6 and 10, as amended, overcome the present objection to the claims. Therefore, withdrawal of the objection to the claims is respectfully requested.

IV. Rejection of Claim 12 Under 35 U.S.C. § 112, 1st ¶

Claim 12 was rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the Specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most

nearly connected, to make and/or use the invention. The Examiner states that she is not certain what is being claimed and that no prior art can be applied to claim 12 until clarification is provided. See Office Action at p. 3. Applicant respectfully traverses this rejection and submits that claim 12 is allowable for the following reasons.

Applicant respectfully submits that the Office Action's present assertions and arguments reflect the subjective beliefs of the Examiner, and therefore simply do not reflect the proper standard for determining whether a patent application complies with the enablement requirement that the Specification describe how to make and use an invention that is defined by the claims. See M.P.E.P. § 2164 (even if a claim feature does "lack descriptive support in the disclosure," this does not mean that the feature is not enabled; a claim feature "in and of itself may enable one skilled in the art to make and use the claim containing" the claim feature).

This standard may not be based on the subjective beliefs of an examiner, but must be based on reasonable arguments that are supported by proper evidence. The Supreme Court established the appropriate standard as requiring the establishment by proper evidence of whether **any experimentation for practicing the invention was undue or unreasonable**. See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988)). Thus, the enablement test is whether "one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art *without undue experimentation*." See *id.* (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988)).

The Federal Circuit has also stated that there are many factors to be considered in determining whether a specification satisfies the enablement requirement. These factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. See *id.* (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). The Federal Circuit has further stated that it is "improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors," and that an examiner's analysis must "consider all the

evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” See M.P.E.P. § 2164.01.

Moreover, to reject the claims as not being enabling, an examiner bears the initial burden of establishing exactly why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” See *id.* (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993)). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. See *id.*

In particular, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of *Ex Parte Reese*, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected, under the first paragraph of 35 U.S.C. § 112, application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner’s subjective belief that the specification was not enabling as to the claims. In particular, the examiner’s subjective belief was simply not supported by any “evidence or sound scientific reasoning” and therefore ignored recent case law -- which makes plain that an examiner, and not an applicant, bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation -- which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. See *id.* Moreover, the Board made clear that it is “incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence,” and also made clear that “[where an] examiner’s ‘Response to Argument’ is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph.” See *id.* at 1222 & 1223 (emphasis in original). Here, it has not even been conclusorily asserted that undue experimentation would be required.

It is believed and respectfully submitted that a person of reasonable skill in the art could make or use the hydropneumatic, level-regulated axle suspension device recited in claim 12 based on the Specification and Figures of the present application coupled with information known in the art without undue experimentation. See the Specification, for example, at p. 5, lines 18 to 27. It is therefore respectfully submitted that claim 12 is fully supported by an enabling disclosure.

In view of the foregoing, it is respectfully submitted that claim 12 fully complies with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

V. Rejection of Claims 1 to 17 Under 35 U.S.C. § 112, 2nd ¶

Claims 1 to 17 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 2 has been canceled thus rendering the rejection of this claim moot. Applicant submits that claims 1 and 3 to 17, as amended, overcome the 35 U.S.C. § 112 rejection. Therefore, withdrawal of the rejection and allowance of claims 1 and 3 to 17 is respectfully requested.

VI. Rejection of Claims 1 to 17 Under 35 U.S.C. § 103(a)

Claims 1 to 17 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,709,394 ("Martin et al.") in view of U.S. Patent No. 5,480,188 ("Heyring"). Claim 2 has been canceled thus rendering the rejection of this claim moot. Applicant respectfully submits that claims 1 and 3 to 17 are allowable for at least the following reasons.

Claim 1 relates to a hydropneumatic, level-regulated axle suspension for front and rear axles on vehicles. Claim 1 recites that the suspension includes two double-acting hydraulic suspension cylinders, whose cylinder spaces are each connected to a first pressure accumulator and whose annuli on a piston side are connected to a second pressure accumulator. Claim 1 further recites that the axle suspension for the front axle and the rear axle is designed as a reversible double-function axle suspension, so that each axle is switchable as an oscillating axle (in a cylinder transverse combination) or as a stabilizing axle (in a cross combination).

Martin et al. purportedly relate to a suspension means for a utility vehicle. Martin et al. state that the vehicle is supported at its front and rear ends by double-acting hydraulic cylinders. See Abstract. During downhill travel the front cylinders are stated to be blocked for fixing the front axle to the frame and the rear cylinders are stated to be hydraulically interconnected to allow the rear axle to oscillate to the frame. See Abstract. A control system for the hydraulic actuator means is stated to include hydraulic control means 26, which are stated to be linked to the double-acting hydraulic cylinders 17, 18, 23, 24 for extension and retraction thereof. See col. 3, line 66 to col. 4, line 2. Head end chambers of the left and right front cylinders 17, 18 are stated to be interconnected by an upper oscillation line 28. See col. 4, lines 3 to 5. A lower oscillation line is stated to be constituted by two hydraulic line portions 29, 79, which are stated to be linked to two ports of an oscillation control valve 85, stated to be a solenoid operated control valve with four ports and two positions and having a rest position shown in FIG. 3, wherein these line portions 29, 79 are stated to be interconnected. See col. 4, lines 5 to 10. The cylinders 17, 18 and the lines 28, 29, 79 are stated to constitute an oscillation structure 27 for the front wheels 3. See col. 4, lines 10 to 12. The weight of the front end of the main frame 2 is stated to be supported by the oil enclosed in the head end chambers of the front cylinders 17, 18 and the upper oscillation line 28. See col. 4, lines 12 to 15. When external action on the rod of the left front cylinder 17 makes the same extend or retract, oil is stated to freely circulate through the oscillation lines 28, 29, 79 between the front cylinders 17, 18, such that the right front cylinder 18 is retracted or extended in the opposite sense. See col. 4, lines 15 to 19. External action on the right front cylinder 18 is stated to have an analogous effect on the left front cylinder 17. See col. 4, lines 20 to 21. When left and right control valves 38, 39 are in their rest positions, the ports thereof are stated to be closed. See col. 4, lines 59 to 60. Martin et al. state that when the oscillation control valve 85 is equally in its rest position, the oil in the left and right control lines 34, 35 cannot escape, such that the pistons of the rear cylinders 23, 24 are blocked by the oil trapped in their head end chambers. See col. 4, lines 60 to 64. Any upward or downward movement of the rear wheels 4 relative to the frame 2 is stated to be impeded, as if they were mounted onto a fixed rear axle 55. See col. 4, lines 64 to 67. Martin et al. further state that, as shown in FIG. 5, oscillation control valve 85 may be actuated to disconnect the lower oscillation line portions 29, 79 and to interconnect the

left and right control lines 34, 35. See col. 5, lines 25 to 28. When the left and right control valves 38 and 39 are kept in their rest positions, the pistons of the front cylinders 17, 18 are stated to be immobilized by the oil trapped in their rod end chambers and the corresponding line portions 29, 79. See col. 5, lines 28 to 31. Hence, Martin et al. state that the front wheels 3 and their virtual axle 56 are kept in a fixed position to the main frame 2. See col. 5, lines 31 to 33.

Applicant submits that the above described "immobilized" state where axle 56 is kept in a fixed position relative to the main frame 2 cannot be considered a stabilizing axle in a cross combination, as recited in claim 1. When axle 56 is in a fixed position the pistons of the front cylinders 17, 18 are stated by Martin et al. to be immobilized by the oil trapped in their rod end chambers and the corresponding line portions 29, 79. See col. 5, lines 28 to 31. Thus, in this "immobilized" state there can be no cross flow between a cylinder space in a cylinder on one end of an axle and an annulus of a cylinder on an opposite end of the same axle, i.e., axle 56 is not in cross combination, as recited in claim 1. The stabilizing axle in a cross combination is shown in Figure 2 of the present application. See also the Specification, for example, at p. 6, line 6 to p. 7, line 1. Further, as admitted by the Office Action at p. 5, Martin et al. do not disclose two double-acting hydraulic suspension cylinders, whose cylinder spaces are each connected to a first pressure accumulator and whose annuli on a piston side are connected to a second pressure accumulator, as recited in claim 1. Therefore, Martin et al. do not disclose all of the limitations of claim 1.

Nor does Heyring cure the deficiencies of Martin et al. Specifically, nowhere does Heyring disclose, or even suggest, an axle suspension for the front axle and the rear axle that is designed as a reversible double-function axle suspension, so that each axle is switchable as an oscillating axle (in a cylinder transverse combination) or as a stabilizing axle (in a cross combination), as recited in claim 1.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the

application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, nowhere does the combination of Martin et al. and Heyring disclose, or even suggest, a suspension including two double-acting hydraulic suspension cylinders, whose cylinder spaces are each connected to a first pressure accumulator and whose annuli on a piston side are connected to a second pressure accumulator, as recited in claim 1. Further, nowhere does the combination of Martin et al. and Heyring disclose, or even suggest, an axle suspension for the front axle and the rear axle that is designed as a reversible double-function axle suspension, so that each axle is switchable as an oscillating axle (in a cylinder transverse combination) or as a stabilizing axle (in a cross combination), as recited in claim 1. Therefore withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claim 1 is respectfully requested.

Since the combination of Martin et al. and Heyring does not disclose, or even suggest, all of the limitations of claim 1 as more fully set forth above, it is respectfully submitted that the combination of Martin et al. and Heyring does not render obvious claims 3 to 17, which ultimately depend from claim 1 and therefore include all of the limitations of claim 1. It is respectfully submitted that claims 3 to 17 are allowable for at least the same reasons that claim 1 is allowable. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious). Therefore withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 3 to 17 is respectfully requested.

VII. Conclusion

Applicant respectfully submits that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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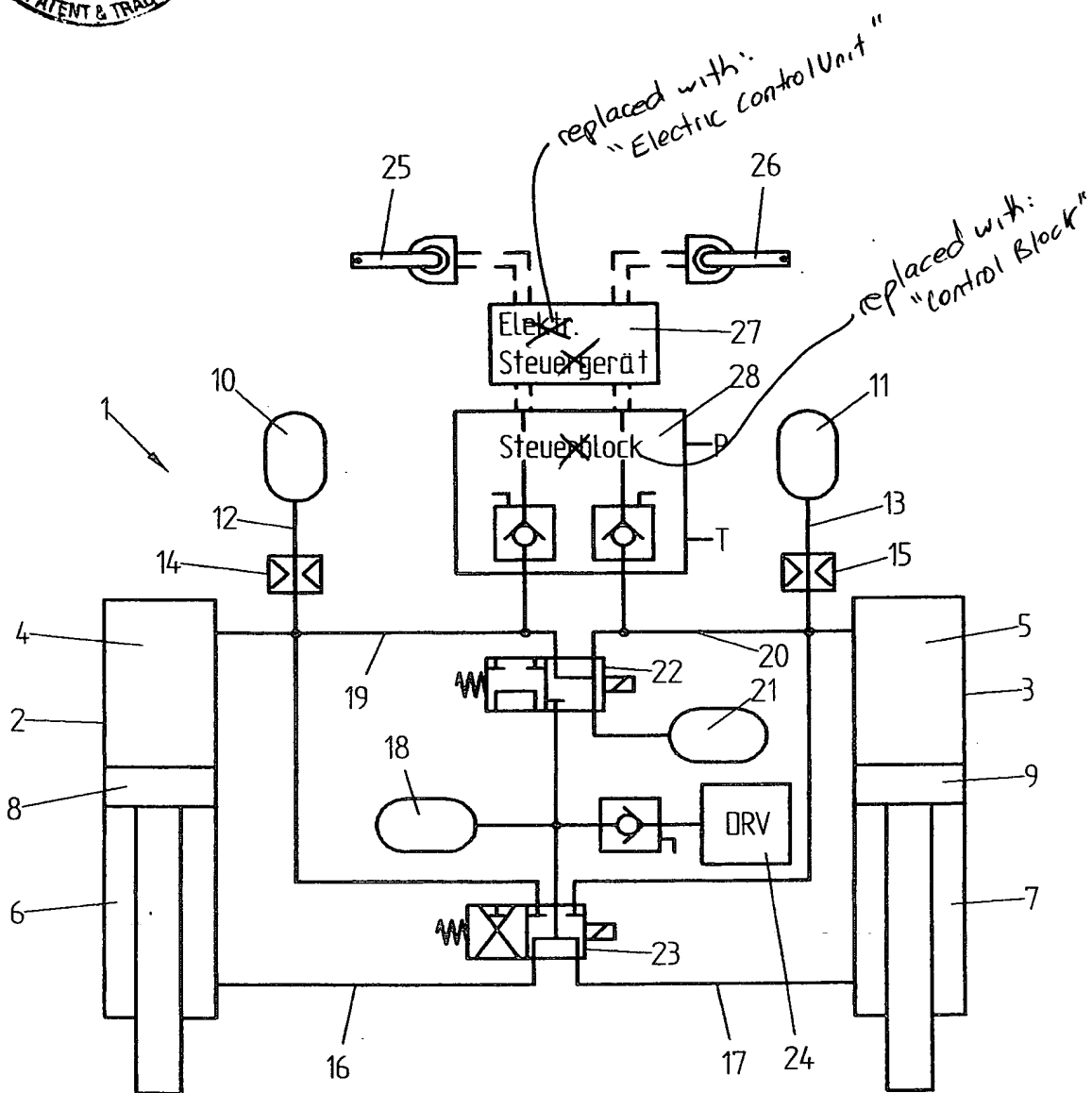


Fig. 1

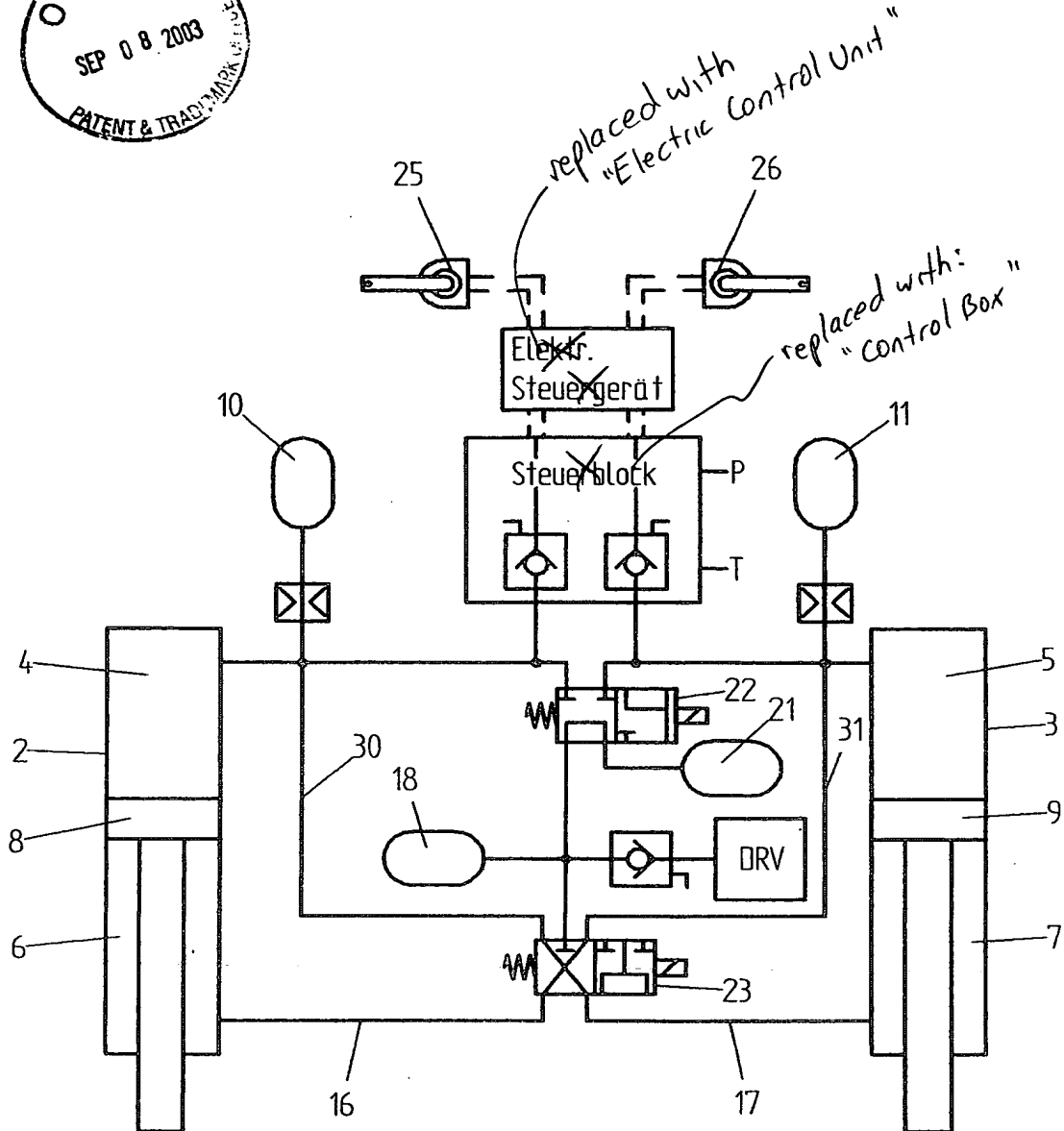


Fig. 2